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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/9/08 has been entered.

#### **Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

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international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-35 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by the Alex Holtz declaration. Disclosed in the declaration are numerous marketing activities by the applicants since 1996 which bring the claimed inventions within the scope of a bar to patenting under 35 USC 102(b), including:

1996: graphically disclosed the invention at the NAB 96 trade show.

4/1997: Demonstrated the first prototype, distributed brochures, market exploitation, proposed price, list of potential beta sites was kept, among which is the Rainbow Media Group. All at the NAB 97.

Sometime after the NAB 97: discussed sale with price to public, including the Rainbow Media Group.

At Infocom tradeshow, repeated the same activities as with the NAB 97.

10/1997: Disclosed the product (with significant source codes), distributed brochures describing features and functions of the products at Telecom 97 tradeshow. Offered sale with price to public, including Rainbow Media Group. Capable and ready for taking purchase order.

12/19/97: Signed a sale contract with Rainbow Media Group.

It has been held that if one discloses his or her own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing

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date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. In this case the filing date of this application is December 18, 1998. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. The proper test for the public use prong of the § 102 (b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Evidences of commercial activities include:

- (A) Preparation of various contemporaneous “commercial” documents, e.g., orders, invoices, receipts, delivery schedules, etc.;
- (B) Preparation of price lists (*Akron Brass Co. v. Elkhart Brass Mfg. Co.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965) and distribution of price quotations (*Amphenol Corp. v. General. Time Corp.*, 158 USPQ 113, 117 (7th Cir. 1968));
- (C) Display of samples to prospective customers (*Cataphote Corp. v. DeSoto Chemical Coatings, Inc.*, 356 F.2d 24, 27, 148 USPQ 527, 529 (9th Cir. 1966) mod. on other grounds, 358 F.2d 732, 149 USPQ 159 (9th Cir.), cert. denied, 385 U.S. 832 (1966); *Chicopee Mfg. Corp. v. Columbus Fiber Mills Co.*, 165 F.Supp. 307, 323-325, 118 USPQ 53, 65-67 (M.D.Ga. 1958));
- (D) Demonstration of models or prototypes (*General Elec. Co. v. United States*, 206 USPQ 260, 266-67 (Ct. Cl. 1979); *Red Cross Mfg. v. Toro Sales Co.*, 525 F.2d 1135, 1140, 188 USPQ 241, 244-45 (7th Cir. 1975); *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 815-16, 131 USPQ 413, 429-30 (D.Del. 1961)),

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especially at trade conventions (InterRoyal Corp. v. Simmons Co., 204 USPQ 562, 563-65 (S.D. N.Y. 1979)), and even though no orders are actually obtained (Monogram Mfg. v. F. & H. Mfg., 144 F.2d 412, 62 USPQ 409, 412 (9th Cir. 1944));

(E) Use of an invention where an admission fee is charged (In re Josserand, 188 F.2d 486, 491, 89 USPQ 371, 376 (CCPA 1951); Greenewalt v. Stanley, 54 F.2d 195, 12 USPQ 122 (3d Cir. 1931)); and

(F) Advertising in publicity releases, brochures, and various periodicals (In re Theis, 610 F.2d 786, 792 n.6, 204 USPQ 188, 193 n. 6 (CCPA 1979); 3 InterRoyal Corp. v. Simmons Co., 204 USPQ 562, 564-66 (S.D.N.Y.1979); Akron Brass, Inc. v. Elkhart Brass Mfg., Inc., 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir.1965); Tucker Aluminum Prods. v. Grossman, 312 F.2d 393, 394, 136 USPQ 244, 245 (9th Cir. 1963)).

As set forth above, evidences of commercial activities from A through F are all shown in Mr. Holtz declaration. Commercial activity was also disclosed on page 9 of the 1997 Annual Report, wherein “The company’s revenues to date consist of sales of CamaraMan systems and various accessories which complement those systems. Revenues for the years ended December 31, 1997, 1996 and 1995 were \$10,799,067, \$9,195,811, and \$3,902,546, respectively”.

The 9/18/96 Preliminary Sales Manual describes the CameraManSTUDIO as having a unique proprietary feature called TransitionMacro which allows the creation of real time

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control sequences. A control sequence can include video effects, audio mix, VCR commands, and camera controls. The TransitionMacro can then be assigned to a single button for playback and can also be edited using a simple GUI editor. A ShotPROFILER records joystick movements. Combining a shot profile with a TransitionMacro will create a very complex transition with an automated camera move. The Preliminary Sales Manual includes price list for the CameraManSTUDIO and its accessories. The CameraManSTUDIO was completed and ready for patented as evident from the printout brochures and the 9/18/96 CameraManSTUDIO Preliminary Sales Manual (see the entire manual). The Preliminary Sale Manual discloses listed functions performed by the CameraManSTUDIO, such as the creating of Transition Macro files, the GUI, the HOT Keys, the Shot Profiles, the Shot Directors, etc... The declaration Exhibit A was disclosed at the trade shows. This exhibit A lists substantially the same functions of the CameraManSTUDIO as in the Preliminary Sale Manual. Exhibit A's disclosed features of Transition Macro files and interactive CameraMan SCRIPT Viewer. Transition Macro and CameraMan Script viewer are time-based commands. The limitation "at least one scripted portion that includes at least one command activated during a predetermined interval in a script that undergoes scrolling for display under control of an operator" appears inherently included in the interactive CameraManSCRIPT Viewer. And the limitation "at least one non-scripted portion that include at least one command activated independent of the script" appears inherently included in the TransitionMacro. It has been held that if a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale,

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whether or not the parties to the transaction recognize that the product possesses the claimed characteristics (*Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1348-49 (Fed. Cir. 1999)).

The 1997 Annual Report, published in 1998, discloses the sale of the CameraManStudio in 1996 and 1997 which are evidences of commercial activities of the claimed invention before the critical date. In certain circumstances, references cited to show a universal fact need not be available as prior art before applicant's filing date. In *re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962).

Mr. Holtz declaration expressly admitted that, in addition to the GUI, various prototypes and marketing documents (exhibits A, C) were displayed and distributed to the public in various trade shows (the declaration, par 3, 5-15).

Experimental use does not include market testing where the inventor is attempting to gauge consumer demand for his claimed invention. The purpose of such activities is commercial exploitation and not experimentation. In *re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). Further, experimentation to determine product acceptance, i.e., market testing, is typical of a trader's and not an inventor's experiment and is thus not within the area of permitted experimental activity. *Smith & Davis Mfg. Co. v. Mellon*, 58 F. 705, 707 (8th Cir. 1893) Likewise, testing of an invention for the benefit of appeasing a customer, or to conduct "minor tune up" procedures not requiring an inventor's skills, but rather the skills of a competent technician," are also not within the exception. In *re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 193-94 (CCPA 1979).

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Par. 8 of the declaration clearly states that proposed prices were provided to potential buyers.

It should also be noted that the terms “production level” and “beta level” of the

The CameraManSTUDIO has multiple versions. The versions presented to the public during the above tradeshow may not be the version of the final version of the CameraManSTUDIO

which the applicant is referring to in the argument. For the clarity of the record, it is

respectfully request that all arguments should be directed to versions of the

CameraManSTUDIO presented to the public one year prior to the filing date of this instant

application. It is the examiner’s opinion that the instant claim limitations were disclosed to

the public in those CameraManSTUDIO versions during the above tradeshow. The terms

“production level” and “beta level” of the CameraManSTUDIO appear directed to the real-

time, live television capability version of the CameraManSTUDIO. In addition, price and

beta version of the CameraManSTUDIO were offered to the public between April 97 and

December 19, 1997 (see the declaration, par11-15). Conditional Sale May Bar a Patent An

invention may be deemed to be “on sale” even though the sale was conditional. The fact that

the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was

for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8,

12 (5th Cir. 1970).

### ***Response to Arguments***

Applicant's arguments filed 6/9/08 have been fully considered but they are not persuasive.

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Remarks: The applicant re-iterates all argument set forth in previous response. It is believe that all argument has been fully addressed as set forth above. Namely, the applicant re-iterates that no commercial exploitation took place at the NAB 97 tradeshow, however evidences of the record as set forth above show the contrary.

### Conclusion

This is a RCE of applicant's earlier Application No. 09/488,578. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ba Huynh

9/26/08

/Ba Huynh/

Primary Examiner, Art Unit 2179